REMARKS

I. OVERVIEW

Claims 1–17 are pending in this application. Claim 7 is canceled, and claims 1, 16, and 17 are amended. New claim 18 is added. Applicants submit that no new matter is added as support for the amended claims exists in the specification and claims as originally filed. In particular, Applicants respectfully submit that written description support for new claim 18 may be found, for example, in Table 2, examples 5 and 6.

III. REJECTIONS UNDER 35 U.S.C. § 102(B) OR 103(A) OVER KITAGAWA

The Office Action has rejected claims 1-17 under 35 U.S.C. §§ 102(b) or 103(a) as being unpatentable over Kitagawa *et al.* (JP 2002-69288) ("Kitagawa").

The present invention is generally directed to compositions obtained by mixing 100 parts by weight of an organic polymer (A) with moisture cross-linkable reactive silane terminal functions and 1 to 70 parts by weight of an organic polymer (B) miscible at ambient temperature with polymer (A), wherein polymer (B) comprises a polyester, a polyurethane, a polyethylenediimine, or mixtures thereof.

The Office Action asserts that claims 1–17 are anticipated by or rendered obvious by Kitagawa as shown in the "Equivalent-Abstracts." According to the Office Action, Kitagawa teaches the combination of components required by Applicants' claims for use as an adhesive. According to the Office Action, the component B of Kitagawa and the component C of Kitagawa—when it is a polyether or polyester—are equivalent to A and B of the claims and are taught in overlapping proportions.

Applicants are submitting a full English translation of Kitagawa in an Information Disclosure Statement filed concurrently herewith.

As stated in the Manual of Patent Examination Procedure § 2112, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference. *Verdegaal Brothers Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)." MPEP § 2112;

Kitagawa states that, "[e]xamples of macromolecular plasticizer (C)…used in the present invention, include an oxyalkylene polymer, a polyester, poly-α-methylstyrene, polystyrene, polybutadiene, an alkyd resin, polychloroprene, polyisoprene, polybutene, hydrogenated polybutene, epoxidated polybutadiene, a butadiene-acrolonitrile copolymer, and the like, as well as mixtures thereof." Kitagawa at pp. 40-41. Accordingly, Kitagawa discloses twelve possible compounds for the macromolecular plasticizer (C), only one of which is a polyester. Moreover, Kitagawa states that preferably, the macromolecular plasticizer (C) is an oxyalkylene polymer (*See* Kitagawa at p. 41), and every specific example disclosed in Kitagawa employs either a polypropylene oxide or a polytetramethylene glycol as the plasticizer (*i.e.* polyethers). *See* Kitigawa at examples 3-1 to 3-4, pages 69-70, plasticizers "K1-K5" in tables 1 and 3, and definition of "K5" in table 5.

Applicants have amended independent claims 1, 16, and 17 to remove recitation of the organic polymer (B) comprising a polyether; however, these claims continue to recite that the organic polymer (B) may comprise, among other compounds, a polyester. In *Sanofi-Synthelabo v. Apotex*, the Federal Circuit recently reiterated that "[t]he reference must clearly and unequivocally disclose the claimed invention or direct those of skill in the art to the invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." 550 F.3d 1075, 1083, (Fed. Cir. 2008) (citations omitted). Applicants respectfully submit that Kitagawa does not anticipate the present

claims for at least the reason that Kitagawa teaches a polyester as only one of twelve different possible plasticizers, requiring one of skill in the art to "pick and choose" polyesters out of a list of eleven other possible plasticizers.

Accordingly, Applicants respectfully submit that this rejection should be withdrawn.

Furthermore, Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

Kitagawa is directed to adhesive compositions with reduced cracking and whitening over time (*See* Kitagawa at p. 1), whereas the present adhesive compositions exhibit long maximum open times and increased tack. Applicants submit that based on the disclosure of Kitagawa, it would not have been obvious to one of ordinary skill in the art seeking to develop an adhesive with greater tack and longer maximum open time to choose to use a polyester plasticizer in the composition of Kitagawa. Although Applicants acknowledge that Kitagawa teaches that its macromolecular plasticizer can be a polyester, this is "mere happenstance" unrelated to formulating an adhesive with increased tack and maximum open time. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)(finding claims non-obvious based on the mere happenstance that the prior art disclosed an overlapping temperature range when the purpose of the temperature range was different in the prior art than the purpose of the temperature range in the claimed invention).

For at least this reason, Applicants respectfully request withdrawal of this rejection.

IV. CONCLUSION

An indication of allowance of all pending claims is respectfully solicited. In the event any issues remain, Applicants would appreciate the courtesy of a telephone call to their counsel to resolve such issues and place all claims in condition for allowance.

Respectfully submitted,

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Dated: July 30, 2010

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	:	10/596,408	Confirmation No.:	6274
Applicant	:	Virginie LUCET et al.		
Filed	:	Jan. 10, 2007		
Title	:	**MOISTURE CROSS-LINKABLE ADHESIVE COMPOSITIONS**		
TC/Art Unit	:	1796		
Examiner:	:	Bernard Lipman		
Docket No.	:	66857.000003		
Customer No.	:	**21967**		

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INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with 37 C.F.R. §§ 1.97 and 1.98, and in compliance with the duty of disclosure set forth in 37 C.F.R. § 1.56, applicants submit attached Form PTO-SB/08A (modified) for consideration and request the references cited therein be made of record by the U.S. Patent and Trademark Office in the above-captioned application.

Applicants respectfully point out that the submission of the listed references in this Information Disclosure Statement is not an admission that they are prior art or that they are material to patentability of any claims of the application. Also, the submission of this Information Disclosure Statement is not an indication that a search has been made by Applicants.

Consideration of the foregoing plus the prompt return of a copy of the enclosed Form SB/08A with the Examiner's initials in the left column in accordance with MPEP 609 are respectfully requested.

This Information Disclosure Statement is being submitted after the mailing of a final Office Action. Pursuant to 37 C.F.R. § 1.97(c)(2), the US Patent and Trademark Office is authorized to charge the requisite fee of $180.00 to the undersigned's Deposit Account No. 50-0206. In the event any variance exists between the authorized amount and the Patent Office charges, please charge or credit any difference to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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